

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of : Application Serial No. 85182971
For the Mark : WORLD TRADE CONSULT, LLC BE SURE...
: IN AN UNSURE WORLD & Design
Published : April 26, 2011

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WORLD TRADE CENTERS ASSOCIATION, INC.,	:
	:
Opposer,	:
	:
v.	:
	:
WORLD TRADE CONSULT, LLC,	:
	:
Applicant.	:
	:
-----X	

Opposition No. _____

BOX TTAB – FEE
Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Arlington, VA 22313-3513

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NOTICE OF OPPOSITION

World Trade Centers Association, Inc. (hereinafter, “Opposer”) believes it would be damaged by a grant of a registration to World Trade Consult, LLC (hereinafter, “Applicant”) based on Application Serial No. 85182971 for the mark WORLD TRADE CONSULT LLC BE SURE... IN AN UNSAFE WORLD & Design filed in International Class 36 on November 22, 2010 and published for opposition on April 26, 2011 (hereinafter, the “Application”), and hereby opposes said Application. A request for an extension of time to oppose the Application was filed by Opposer and granted by the Board, providing Opposer until August 24, 2011 to file an opposition.



08-25-2011

PARTIES

A. Applicant

Upon information and belief, Applicant World Trade Consult, LLC is a Missouri corporation with a principal place of business at 540 Lexington Landing Drive, St. Charles, Missouri 63303.

B. Opposer

Opposer World Trade Centers Association, Inc. is a Delaware corporation with a principal place of business at 420 Lexington Avenue, Suite 518, New York, New York 10170.

GROUND FOR OPPOSITION

The grounds for opposition are:

1. Opposer is a membership organization with more than three hundred members in the United States and over seventy other countries. Its activities are directed at the promotion of international trade and business relationships. Such activities include developing and certifying World Trade Centers (hereinafter, "Members"), facilitating the cooperative exchange of trade services and trade information among its Members, and licensing the offering of trade services and trade information to the public by its Members under the "World Trade Center" name.

2. Opposer is the owner of the globally renowned marks and trade names "WORLD TRADE CENTER" and "WTC," and the Map Design Logo service mark, both in the United States and elsewhere. These marks and names have long been used for the aforementioned activities, including trade consulting services in the areas of trade credit insurance, and trade financing.

3. In addition to its common law rights, Opposer is the owner of the following valid, subsisting, unrevoked and uncanceled Federal Registrations, of the underlying marks, and of the

corresponding trade names, used in connection with “association services – namely, fostering and promoting world trade and international business relationships” in International Class 42:

Description of Mark	Registration No.	Registration Date	Date of First Use
“Map Design Logo”	1,011,720	May 27, 1975	May, 1973
WORLD TRADE CENTER	1,469,489	Sept. 26, 1986	March, 1961
WTC	1,749,086	Jan. 26, 1993	April, 1968

Printouts from the Patent and Trademark Office website showing proof of these registrations are annexed as Exhibit A to this Notice of Opposition. These Federal Registrations and Opposer’s common law and statutory rights to these marks are hereinafter referred to collectively and severally as “Opposer’s Marks.”

4. Opposer’s Marks have been used for decades by Opposer and its Members, who use Opposer’s Marks pursuant to license, which use inures to the benefit of Opposer. Opposer’s Marks are used to identify Opposer and its Members as the sponsors and/or providers of the trade-related activities and services provided under the “World Trade Center” and “WTC” names, and “Map Design Logo.”

5. Opposer’s WORLD TRADE CENTER mark, WTC mark, and “Map Design Logo” mark are used worldwide by Opposer and its more than three hundred Members and are registered in more than 70 countries, with applications pending in an additional 15 countries.

6. Opposer’s “Map Design Logo” mark consists of a flattened world globe image appearing as interrupted projections of the world’s continents. Opposer and its licensed Members use the “Map Design Logo” mark in conjunction with Opposer’s WORLD TRADE CENTER mark as part of their regular course of business, and the two marks are registered as a combined word and design mark in at least 22 countries, appearing as follows:



7. Opposer's above-described marks are, and have become, valuable assets of Opposer, with extremely valuable goodwill and a valuable reputation. Opposer and its licensed Members have used the combined marks WORLD TRADE CENTER and "Map Design Logo" in commerce continually since 1973 in connection with Opposer's Services, and for nearly 40 years Opposer has expended considerable time, effort and resources to develop, advertise, market and license services bearing the WORLD TRADE CENTER, WTC and "Map Design Logo" marks, separately and in combination.

8. For years prior to the filing of the Application, Opposer, its Members, and their activities (including Opposer's Marks) received substantial attention in the news media. Opposer, its Members, and their activities have been the subject of additional extensive press and media coverage following the destruction of the World Trade Center buildings in New York City on September 11, 2001, of which Opposer was the namesake. Such extensive media coverage has continued with the recent reconstruction of the World Trade Center building complex in New York, which is being done under license by Opposer.

9. The longstanding and prominent use of Opposer's Marks by Opposer and its licensed Members has generated goodwill and widespread consumer recognition for these marks as exclusively identifying Opposer, its Members, and their trade-related services. Trademark authorities in numerous countries have acknowledged the level of international notoriety achieved by Opposer's marks, having declared them to constitute "well known" and/or "famous"

marks. A U.S. District Court issued a consent judgment in 1996 decreeing that Opposer's marks and names "have become famous," warranting injunctive relief against infringement.

10. Applicant filed its Application on November 22, 2010, claiming a first-use date of October 27, 2010. Applicant's Mark is comprised of a design (a flattened world globe image appearing as interrupted projections of the world's continents) and a word mark, of which the most prominent words are "WORLD TRADE CONSULT". The word and design mark appears in the Application as follows:



11. Applicant's Mark incorporates and plays upon Opposer's Marks by incorporating a map device, which closely mimics Opposer's "Map Design Logo" mark, with the principal words "WORLD TRADE CONSULT," which similarly mimics Opposer's "WORLD TRADE CENTER" mark. Applicant's Mark is a colorable imitation of, and evokes the commercial identity of, the Opposer's Marks.

12. As of the Application's publication date, Applicant's website, which bears Applicant's Mark, also promoted Applicant's business activities under the name "WTC," which is identical in all respects to Opposer's "WTC" mark that has been in commercial use by Opposer since April 1968 and registered with the Patent and Trademark Office since January 26, 1993 – both well before Applicant's use of "WTC." Applicant's unauthorized use of Opposer's "WTC" mark clearly aggravated the potential for both confusion and dilution.

13. Applicant seeks to register Applicant's Mark in International Class 36 for use in connection with "brokerage in the field of trade credit insurance."

14. Opposer's Marks, which have been in commercial use at least 25 years prior to Applicant's Mark, have been used in connection with trade consulting services in the areas of trade credit insurance and trade financing in the United States and internationally.

15. In addition to Opposer's common law rights with respect to the commercial use of Opposer's Marks for such services, Opposer's Marks are registered in International Class 36 in ten countries, including Mexico, Brazil, France, Italy, and the United Kingdom, for use in connection with "insurance and finance." Opposer's WORLD TRADE CENTER mark is also registered with the New York Department of State as a service mark in Class 36 (formerly Class 102), such registration first issuing on November 14, 1985 for use since 1970 in connection with "operating facilities for commodities trading, promotion of financial commerce exchange."

COUNT I

LIKELIHOOD OF CONFUSION

16. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 15 herein.

17. The Applicant's Mark proposed for registration by Applicant incorporates the principal elements of Opposer's Marks by including a map device, which closely mimics Opposer's "Map Design Logo" mark, with the words "WORLD TRADE CONSULT," which similarly mimics Opposer's "WORLD TRADE CENTER" mark.

18. The Applicant's Mark proposed for registration by Applicant is confusing similar to Opposer's Marks because they are similar in appearance, pronunciation and overall connotation.

19. Applicant's Mark is intended to be used for services in the same general market, and provided in the same channels of trade as the services offered by Opposer and its licensed Members under Opposer's Marks.

20. If Applicant is permitted to register and use Applicant's Mark, as specified in its application, confusion in trade and in the minds of the public resulting in injury to the Opposer would likely result. Persons familiar with Opposer's Marks would likely buy Applicant's services as and for services offered by Opposer and its licensed Members or at least believe Applicant's services were sanctioned, authorized, licensed by or related to Opposer and/or its licensed Members. Furthermore, any defect, objection or fault found with Applicant's services marked under its mark would likely reflect upon and injure the reputation that Opposer and its licensed Members have established with respect to the services sold under the Opposer's Marks.

21. Applicant's Mark so resembles Opposer's previously used and registered marks "Map Design Logo" and "WORLD TRADE CENTER" as to be likely, when applied to the services set forth in the Applicant, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act.

22. If the Applicant were granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its mark. Such registration would be a source of damage and injury to the Opposer.

COUNT II

DILUTION

23. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 22 herein.

24. Opposer will be damaged by the continued use and registration by Applicant of Applicant's Mark in that the mark is substantially similar to Opposer's Marks and is used in connection with services related to the services offered to the public by Opposer's licensed Members.

25. Through Opposer's and its Members' extensive advertising and promotion, Opposer's Marks have become distinctive and famous. Any use of Applicant's Mark occurred long after Opposer's Marks have become distinctive and famous. Applicant's Mark is likely to blur or tarnish the positive associations of Opposer's world-famous marks. Thus, in addition, if Applicant were granted the registration herein opposed, it would cause dilution of the distinctive quality of Opposer's well-known marks.

26. If the Applicant were granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its mark. Such registration would be a source of damage and injury to the Opposer.

RELIEF REQUESTED

WHEREFORE, the Opposer prays that the Application Serial No. 85182971 be rejected, and that the registration of the mark therein, sought for the services specified in International Class 36, be denied and refused in accordance with 15 U.S.C. §1052(d), and that this opposition is sustained.

Dated: New York, New York
August 24, 2011

Respectfully submitted,

World Trade Centers Association, Inc.

By: *Scott A. Archie*
General Counsel

World Trade Centers Association, Inc.
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New York, NY 10170 U.S.A.
Tel: (212) 432-2648
Fax: (212) 488-0064
Email: srichie@wtca.org

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with Federal Express under label number 859465941647 addressed to: Commissioner of Trademarks, Trademark Trial and Appeal Board, 600 Dulany Street, Madison East Bldg. Concourse Level Room C55, Alexandria, VA 22313 on the date shown below:

Audrey D. Wilkins
Typed or Printed Name of Person Signing Certificate
Audrey D. Wilkins
Signature
8/24/11
Date

EXHIBIT A

Int. Cl.: 42

Prior U.S. Cl.: 100

United States Patent and Trademark Office

10 Year Renewal

Reg. No. 1,011,720

Registered May 27, 1975

Renewal Term Begins May 27, 1995

**SERVICE MARK
PRINCIPAL REGISTER**



WORLD TRADE CENTERS ASSOCIA-
TION, INC. (DELAWARE CORPORA-
TION)

1 WORLD TRADE CENTER
NEW YORK, NY 10048

FOR: ASSOCIATION SERVICES—
NAMELY, FOSTERING AND PROMOT-

ING WORLD TRADE AND INTERNA-
TIONAL BUSINESS RELATIONSHIPS,
IN CLASS 42 (U.S. CL. 100).

FIRST USE 5-0-1973; IN COMMERCE
5-0-1973.

SER. NO. 73-008,102, FILED 12-5-1973.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on June 6, 1995.*

COMMISSIONER OF PATENTS AND TRADEMARKS

Int. Cl.: 42

Prior U.S. Cl.: 100

United States Patent and Trademark Office

Reg. No. 1,469,489

Registered Dec. 15, 1987

**SERVICE MARK
PRINCIPAL REGISTER**

WORLD TRADE CENTER

WORLD TRADE CENTERS ASSOCIATION,
INC. (DELAWARE CORPORATION)
ONE WORLD TRADE CENTER
NEW YORK, NY 10048

FIRST USE 3-0-1961; IN COMMERCE
3-0-1961.

SEC. 2(F).

FOR: ASSOCIATION SERVICES - -NAMELY,
FOSTERING AND PROMOTING WORLD
TRADE AND INTERNATIONAL BUSINESS
RELATIONSHIPS, IN CLASS 42 (U.S. CL. 100).

SER. NO. 622,458, FILED 9-26-1986.

EDWARD NELSON, EXAMINING ATTORNEY

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Int. Cl.: 42

Prior U.S. Cl.: 100

United States Patent and Trademark Office

Reg. No. 1,749,086

Registered Jan. 26, 1993

**SERVICE MARK
PRINCIPAL REGISTER**

WTC

WORLD TRADE CENTERS ASSOCIATION,
INC. (DELAWARE CORPORATION)
1 WORLD TRADE CENTER, SUITE 7701
NEW YORK, NY 10048

FIRST USE 4-17-1968; IN COMMERCE
4-17-1968.

OWNER OF U.S. REG. NO. 1,469,489.

FOR: ASSOCIATION SERVICES; NAMELY,
FOSTERING AND PROMOTING WORLD
TRADE AND INTERNATIONAL BUSINESS
RELATIONSHIPS, IN CLASS 42 (U.S. CL. 100).

SER. NO. 74-278,551, FILED 5-21-1992.

KEVIN PESKA, EXAMINING ATTORNEY

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: Trademark Application No.:
Mark: WORLD TRADE CONSULT, LLC BE SURE...
IN AN UNSURE WORLD (& Design)
Filed: November 22, 2010

WORLD TRADE CENTERS ASSOCIATION, INC.,

Opposer,

v.

WORLD TRADE CONSULT, LLC,

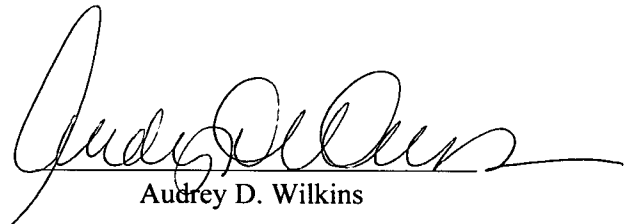
Applicant.

CERTIFICATE OF SERVICE

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

THIS IS TO CERTIFY that on August 24, 2011, I served a copy of the within Notice of Opposition via Federal Express upon:

Mr. John R. Koch
World Trade Consult, LLC
540 Lexington Landing Drive
Saint Charles, MO 63303


Audrey D. Wilkins